



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,185	04/22/2004	Takao Ogino	H 50003 HST	7723

423 7590 07/13/2006

HENKEL CORPORATION  
THE TRIAD, SUITE 200  
2200 RENAISSANCE BLVD.  
GULPH MILLS, PA 19406

EXAMINER
----------

RAZA, SAIRA B

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

4

<b>Office Action Summary</b>	Application No. 10/830,185	Applicant(s) OGINO ET AL.	
	Examiner Saira Raza	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, Claims 17-19 in the reply filed on March 24, 2006 is acknowledged. The traversal is on the ground(s) that an undue search burden does not exist. This is not found persuasive because the inventions have acquired a separate status in the art in view of their different classification, hence restriction for examination purposes as indicated is proper. Additionally, each invention would require a separate search strategy and consequently places an undue search burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in JP on 10/22/2001. It is noted, however, that applicant has not filed a certified copy of the JP 2001-323876 and JP 2001-338312 applications as required by 35 U.S.C. 119(b).

3. Applicant is requested to submit clear and legible documents in any subsequent correspondence with the USPTO.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

5. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Milligan (US 5,663,215).

6. Milligan discloses a composition comprising a polymer (A), which comprises 1-50% molar ratio of a monomer (A1) to (A2); an example of (A2) includes methacrylic acids and their amide derivatives (col. 4, lines 45-54; col. 5, lines 40-42). The composition also comprises a polysiloxane component (B), which further comprises a silane coupling agent in an amount of 0.05-10% by weight, based on the weight of component (B) in the composition (col. 11, lines 58-62). The composition further comprises zirconium, a catalyst, present in an amount of 0.01-5% by weight, based on the weight of the total composition (col. 8, lines 17-22; col. 10, lines 9-11). Wherein upon calculation of the claimed ratios, the ranges disclosed by Milligan overlap and hence anticipate the claimed ratio ranges. Wherein Milligan does not disclose the present of chromium in the compound, hence it is inherent that the composition does not contain chromium. Miligan discloses that the composition can be used as a surface treatment for various structures made of metal (col. 1, lines 13-18).

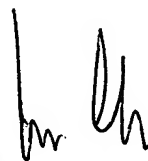
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saira Raza whose telephone number is (571) 272-3553. The examiner can normally be reached on Monday-Friday from 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1711

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**James J. Seidleck**  
**Supervisory Patent Examiner**  
**Technology Center 1700**